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1624	

  

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/593,316	<b>Applicant(s)</b> HEISCHKEL ET AL.	
	<b>Examiner</b> /Venkataraman Balasubramanian/	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

Applicants' response, which included amendment to claim 4, 8 and 15, filed on 12/07/2010, is made of record. Claims 1-32 are pending. In view of applicants' amendment and response, the 112 second paragraph rejection of claim 8, 10-11 and 15-18 and the 101 rejection of claims 10-11 & 16-18 have been obviated. However, the following rejections made in the previous office action are maintained.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7,9-12,15-18 and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The amended claim 4 and its dependent claims 5, 9, 11, 25, 26 are indefinite as it is not clear what triazine carbamates or triazine urea is embraced in the amended claim 4. As recited it is product by process claim and involves reaction of compound IV or 2,4,6-triisocynato-1,3,5-triazine with an alcohol or an amine. Since the structure shown therein by the amendment relates to triazine carbamate of formula I, it is not clear how a reaction of compound IV or 2,4,6-triisocynato-1,3,5-triazine would result in a triazine carbamate. It is not clear what structural make-up of the triazine claimed therein is.

This rejection is a modified rejection of that made in the previous office action. The rejection is modified to address additional issues raised by the amendment.

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Applicants' amendment to claim 4 did not overcome this rejection Applicants' traversal is not persuasive as it failed address all issues raised in the rejection. The structural make-up of the compound formed by the process of recited in claim 4 would include triazine urea but the structure shown in claim 1 and now incorporated in claim 4 is limited to triazine carbamate of formula I. As recited, one is asked to assume that reaction of an amine with compound IV or 2,4,6-trisisocyanoto-triaizne would lead to the structural make-up of the product of formula I, which is technically incorrect. Hence claim 4 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 4 and 5 clearly mismatch with product of the process of claim 4.

2. The amended claims 6 and 7 and their dependent claims 27-30 are indefinite as it is not clear what triazine carbamate is embraced in the amended claims 6 and 7. As recited , the preamble of the claims recite a process for preparing compound of formula I in claim 6 and process for preparing compound of formula I, and I, II & III in claim 7. As recited, one is asked to guess the structural make-up of the product by reacting compound IV in claim 6 and by reacting compound IV or 2, 4, 6-trisisocyanoto-triaizne with an alcohol or amine in claim 7. Hence claims 6 and 7 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group

reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 6 and 7 remains unknown.

This rejection is same as that made in the previous office action. Applicants' traversal is not persuasive as it failed address all issues raised in the rejection. The structural make-up of the compound formed by the process of recited in claim 6 would include triazine urea but the structure of formula I is triazine carbamate. As recited, one is asked to assume that reaction of an amine with compound IV or 2,4,6-trisisocyanototriazine would lead to the structural make-up of the product of formula I, which is technically incorrect. The same is true for claim 7, which recites formula I, II and III. The structural make-up of the compound formed by the process of recited in claim 7 would include triazine urea but the structure of formula I is triazine carbamate. As recited, one is asked to assume that reaction of an amine with compound IV or 2,4,6-trisisocyanototriazine would lead to the structural make-up of the product of formula I, which is technically incorrect. It is also noted that the recited formula that follows the amine are not amine. Hence claim 6 and 7 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 6 and 7 clearly mismatch with product of the process of claim 6 and claim 7 respectively.

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3. Recitation of "at least one methacryloyl or acryloyl group is selected from the group consisting of polyether (meth)acrylates, polyesterol (meth)acrylates, urethane (meth)acrylates and epoxy (meth) acrylates renders claim 5 is indefinite as it is not clear what the intended structural make-up of the radiation-curable 1,3,5-triazine carbamate claimed therein. Note methacryloyl and acryloyl group well defined functional groups while polyether (meth)acrylates, polyesterol (meth)acrylates, urethane (meth)acrylates and epoxy (meth) acrylates polymers and do not have the methacryloyl or acryloyl group. As result, the scope of claim 5 is out side the scope of claim 4 which require a methacryloyl and acryloyl group. Hence, claim 5 is an improper dependent claim.

This rejection is same as made in the previous office action. Applicants' traversal is not persuasive. The issue is not what a methacryloyl or acryloyl group is. Examiner clearly indicated what these groups are. The issue is what is the reactant embraced in polyether(meth)acrylates, polyesterol(meth)acrylates, urethane(meth)acrylates and epoxy(meth)acrylates polymers. These are polymers and it is not clear how would they bear a methacryalte group, namely  $C(CH_3)=CH_2$  needed in formula I.

4. The amended claim 12 is indefinite as it is not clear what triazine carbamate is embraced in the amended claim 12. As recited, the preamble of the claim recites a process for preparing compound of formula I in claim 2. As recited, one is asked to guess the structural make-up of the product by reacting compound IV in claim 12 with an alcohol or an amine. Hence claim12 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the

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amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the radiation curable triazine carbamate claimed in claim 12 remains unknown.

This rejection is same as that made in the previous office action. Applicants' traversal is not persuasive as it failed address all issues raised in the rejection. The structural make-up of the compound formed by the process of recited in claim 12 would include triazine urea but the structure shown in claim 1 is limited to triazine carbamate of formula I. As recited, one is asked to assume that reaction of an amine with compound IV would lead to the structural make-up of the product of formula I, which is technically incorrect. It is also noted that the recited formula that follows the amine are not amine. Note also claim 2 requires  $R^4$  group. Hence claim 12 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the reaction of a compound containing amino group reaction assuming the amino group is the reactant will results in triazine urea and or a triazine containing one more carbamate and urea group. Thus the structural make-up of the triazine carbamate claimed in claim 2 clearly mismatch with product of the process of claim 12.

5. Claim 12 is also an improper dependent claim as it recites a variable group  $R^3$  which is not in claim 2 on which claim 12 is dependent. See choice of alcohols. The scope of claim 12 is therefore out side the scope of claim 2.

This rejection is same as made in the previous office action but now corrected to indicate  $R^3$  group instead of  $R^2$  pointed out in the previous office action. Applicants'

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traversal is not persuasive. Contrary to applicants' urging, as recited  $R^1$ ,  $R^2$  and  $R^3$  are independent variables and hence one cannot substitute one for another without explicit recitation. Hence, this rejection is proper and is maintained.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-9, 11, 12, 15, 18 and 25-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for process for making triazine carbamate of formula I or formula II and III wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1-C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV or by reacting 2,4,6-triisocyanato-1,3,5-triazine wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1-C_4$  alkyl with a compound containing a hydroxyl of formula  $H-X^1-R^1-O-Z^1$ ,  $H-X^2-R^2-O-Z^2$  and  $H-X^3-R^3-O-Z^2$  wherein  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, does not reasonably provide enablement for process for making triazine carbamate of formula I, formula II or formula III, wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1-C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1-C_4$  alkyl with any compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group as embraced in claim language. The specification does



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not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and hence use the invention commensurate in scope with these claims.

In evaluating the enablement question, following factors are considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The instant invention of claims 4 and 5 are drawn to a product of undefined structure by reacting compound of formula IV with a compound containing a hydroxyl or amine and at least one methacryloyl or acryloyl group, claims 6 and 12 are drawn to a process of making compound of formula I by reacting compound of formula IV with a compound containing a hydroxyl or amine and at least one methacryloyl or acryloyl group while claims 7 and 8 are drawn to process for making triazine carbamate of formula I, formula II, formula III, formula V and formula VI, by reacting 2,4,6-triisocyanato-1,3,5-triazine with a compound containing a hydroxyl or amine bearing at least one methacryloyl or acryloyl group,

Specification, while enabled enabling for process for making triazine carbamate of formula I or formula II or formula III or formula V or formula VI wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1$ - $C_{12}$

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alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV or wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1$ - $C_4$  alkyl or by reacting 2,4,6-triisocyanato-1,3,5-triazine with a compound containing a hydroxyl of formula  $H-X^1-R^1-O-Z^1$ ,  $-H-X^2-R^2-O-Z^2$  and  $H-X^3-R^3-O-Z^2$  wherein  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, does not reasonably provide enablement for process for making triazine carbamate of formula I or formula II or formula III or formula V or formula VI, wherein in the groups  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$ ,  $R^1$ ,  $R^2$  and  $R^3$  are each independently  $C_1$ - $C_{12}$  alkyl,  $X^1$ ,  $X^2$  and  $X^3$  is oxygen,  $Z^1$ ,  $Z^2$  and  $Z^3$  bear at least one methacryloyl or acryloyl group, by reacting triazine carbamate of formula IV wherein  $R^4$ ,  $R^5$  and  $R^6$  are each independently  $C_1$ - $C_4$  alkyl or by reacting 2,4,6-triisocyanato-1,3,5-triazine with any compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group as embraced in claim language.

As recited, the scope of the process of the product of claim 4 remains unknown as the final product structure is not recited and disclosed in the claim. Hence, it is not possible to examine the scope of the process or the product. As pointed out before, for search and examination purpose scope of claims 1, 2 and 3 is used.

In addition, all the above process claims, structural make-up of the alcohol is not clearly defined. The reactants for the process are recited as a compound containing a hydroxyl or amino group and at least one methacryloyl or acryloyl group.

Therefore, the processes of claims 4-8 and 12 imply that the reaction of any compound containing a hydroxyl and at least one methacryloyl or acryloyl group with

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compound of formula IV or 2,4,6-triisocyanto-1,3,5-triazine would occur selectively leading to triazine carbamate of formula I, II, III, V or VI for which there is no enabling disclosure. This is clearly chemically incorrect as the transesterification and addition to isocyanato group embraced in these processes would incorporate the reactant alcohol and unless the alcohol is same as those in the final product, the resultant product would be outside the scope of the product of formula I, II, III, V and VI. Specification has no teaching or suggestion as how to perform such process to arrive the desired final product of formula I, II, III, V and VI.

Similarly, the process of claims 4-8 and 12 embraced triazine carbamate of formula I, II, III, V, and VI by reacting triazine carbamate of formula IV or by reacting 2,4,6-triisocyanto-1,3,5-triazine with a compound containing amino group and at least one methacryloyl or acryloyl group, for which there is no enabling disclosure.

This is again not known in the art and such a reaction is also chemically not possible as reaction of carbamate group with any amine as recited will result in urea group by displacement of the alcohol component of the carbamate group. Similarly, addition of amine to isocyanato group as claimed in process claims 7 and 8 will lead to urea not a carbamate as claimed in these processes.

Specification has no teaching or suggestion as to how to perform said process as embraced in the instant claims to arrive at compound of formula I, II, III, V and VI.

2. The predictability or lack thereof in the art:

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Hence the process as applied to the above-mentioned compounds claimed by the applicant is not an art-recognized process and hence there should be adequate enabling disclosure in the specification with working example(s).

3. The amount of direction or guidance present:

Example illustrated in the experimental section or written description offers no guidance or teachings as to how perform the process of making triazine of formula I, II, III, V and VI with the given choices of variable groups and given choices of alcohols and amines as embraced in the instant invention.

4. The presence or absence of working examples:

Although example 1 shows the process for making triazine carbamate of formula I, it is limited to the process wherein  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  are same and do not include variable choices for  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  alcohols or amines in starting material and final product bearing different  $X^1-R^1-O-Z^1$ ,  $X^2-R^2-O-Z^2$  and  $X^3-R^3-O-Z^2$  and different  $R^4$  and  $R^5$  and  $R^6$

5. The breadth of the claims:

Specification has no support, as noted above, for making compound of formula I, II and III reacting compound of formula IV with various alcohols and amines as embraced in  $R^1$ ,  $R^2$ ,  $R^3$ ,  $X^1$ ,  $X^2$ ,  $X^3$ ,  $Z^1$ ,  $Z^2$  and  $Z^3$  choices. There is no support for the process generically embraced in claims 4-8 and 12 would lead to claimed compound of formula I, II, III, V and VI.

6. The quantity of experimentation needed:

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The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired structure, namely compound of formula I, II, III, V and VI embraced in the instant claims 4-8 and 12.

Also, note MPEP 2164.08(b) which states that claims that read on "... significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative.". Clearly that is the case here.

Thus, factors such as "sufficient working examples", the "level of skill in the art and predictability, etc. have been demonstrated to be sufficiently lacking in the case for the instant claims.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or

use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)."

That conclusion is clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

This rejection is same as made in the previous office action. Applicants' traversal is not persuasive as applicants have not addressed the issue of triazine urea formation with an amine or amine of formula recited therein in these rejected claims. The formula shown are alcohols and not amine. In addition applicants have not shown how one would able to transesterification selectively displacing R<sup>5</sup> and R<sup>6</sup> without displacing require R<sup>4</sup> in compound of formula shown in claim 2.

Hence, this rejection is deemed as proper and is maintained.

### ***Double Patenting***

Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 4 is a product by process claim wherein the product is claimed in claim 1. A product is a product irrespective of how it is made. The processes attributes are independent limitation and do not necessarily define the structural make-up of the product. The claim 4 is not rendered patentably distinct by a process directed to its preparation even though the process may be patentable. Note "Determination of

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patentability in "product by process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process" In re Thorpe 227 USPQ 964. Also note In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), the court held that "The lack of physical description in a product by process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established."

Hence, if claim 1 were found allowable, claim 4 will be rejected and its dependent claims 5, 9 and 11 will be objected to.

This objection is same as made in the previous office action. Applicants' traversal is not persuasive. First, applicants have not provided any evidence that the scope of claim 4 is not the same as claim 1. Second, a product is a product irrespective of how it is made. The structural make-up of the product would be the same irrespective of the processes used to make the product. Applicants have not shown that the structural make-up of the product of claim 4 is different from claim 1. In fact, the process embedded in claim 4 has the reaction IV with various alcohol as well as the reaction of said alcohols with by reacting 2,4,6-triisocyanato-1,3,5-triazine. Thus, claim 4 clearly claims the product formed from either of the said process is same. Claim 4 clearly provides evidence that a product is product irrespective of the process of making. Hence, this objection if applied as a rejection is proper and is maintained.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 12-15 and 19-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-49 of copending Application No. 10/593,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the triazine carbamates and triazine urea and the process of making them embraced in claims are obvious over the process making triazine carbamate and triazine urea embraced in the earlier filed copending application 10/593,308. More specifically, instant claims 1, 2, 4 and 5 recite triazine carbamate and triazine urea while the process claims 36-49 of earlier filed copending application recites a process of making triazine carbamate and triazine urea which include instant triazine carbamate and triazine urea. One trained in the art in practicing the process of claims 36-49 would make the instant triazine



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carbamate and triazine urea. See claims 36-49, note the triazine of formula (I) with various variable groups includes instant triazine carbamate and triazine urea. Furthermore, the process of claims 36-49 includes instant process of transesterification and amidation. Hence, it would be obvious to one trained in the art to practice the process with various choices of variables and make triazine carbamate and ureas of formula (I) including instant compounds and expect them to have the use taught therein.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection is same as made in the previous office action. Applicants' traversal to overcome this rejection is not persuasive for reasons of record. The fact that the copending application and the current application are filed on the same date does not imply that they will held commonly. Besides, the undue extension of patent term, the issued patents of these application have to be common assigned.

Applicants' response indicates that they may consider filing a Terminal Disclaimer to obviate this rejection.

Hence, this rejection is maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624